

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

EX PARTE *SMITH* et al.

Application for Patent

Filed: July 31, 2003

Application No. 10/633,020

FOR:

SMART CARD PERSONALIZATION ASSISTANCE TOOL

Examiner Giovanna Colon, Art Unit 2162

REPLY BRIEF

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Signed: /Ann Lowe/
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I. STATUS OF CLAIMS

Allowed claims:	None
Claims objected to:	None
Claims cancelled:	7-10 and 17-35
Claims rejected:	1-6 and 11-16
Claims on appeal:	1-6 and 11-16

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The rejections presented for review are as follows:

Claims 1-3, 6, 11-13 and 16 are rejected under 35 U.S.C. §103 as being unpatentable over *Tushi et al.* (U.S. Pat. No. 6,014,748) in view of Du (U.S. Pub. No. 2001/0042212). Claims 4, 5, 14, and 15 are rejected under 35 U.S.C. §103 as being unpatentable over *Tushi et al.* in view of Du, and further in view of *Anderson et al* (U.S. Pat. No. 5,884,289).

III. ADDITIONAL ARGUMENTS

A. The Combination of *Tushie* and *Du* Does Not Disclose “smart card feature”

In the Examiner’s Answer, it is argued that *Tushie* and *Du* disclose smart card features. In the context of the pending claims, a smart card feature is a parameter representing a business requirement of the smart card issuer and dictates smart card usage. For example, a smart card feature may indicate whether the card issuer will require a signature or PIN when the card is used. Smart card features have no bearing to specific cardholders or their data. *Tushie* describes specific cardholder data of an individual stored on a smart card. This cardholder data may include types of services the cardholder is entitled to, account limits for those services, and cardholder applications, such as medical applications or accounting applications. Although this data is more elaborate or complex compared to account name, number, or expiration date, it is still data specific and unique to an individual cardholder. The medical application or accounting service is also still data that relates to the cardholder. It is not data that relates to features as decided by a smart card issuer.

Claims 1 and 11 recite that “a smart card feature is a parameter representing an issuer business requirement dictating smart card usage.” Thus, the claims explicitly state that a smart card feature is a business management requirement of the smart card issuer, and does not directly relate to a specific cardholder. Examples of smart card features as recited in the claims are provided on pages 4 and 5 in the Appeal Brief and are not repeated here. These examples make it clear that cardholder data and even more elaborate data, such as services and applications, are not smart card features. They do not represent a business requirement of the smart card issuer. More importantly, claim 1 requires that the features are applied to the entire batch of smart cards, not to a single cardholder.

B. The Combination of *Tushie* and *Du* Does Not Disclose Querying a Smart Card Issuer and Receiving Responses Reflecting Smart Card Features

The Examiner's Answer states that the combination of references discloses querying a user about smart card features and receiving responses regarding those features. We note here that a "user," as recited in the pending claims, is an employee (or agent) of the smart card issuer and is the person running the personalization software tool on the card issuer system. As such, the "user" is not a cardholder. The Examiner's Answer cites portions of *Du* that describe querying an end-user using a personal computer for information regarding the end-user's personal computing environment and preference settings, which are eventually stored on a smart card. The smart card is then be taken by the end-user and inserted into another personal computer, for example in a different country, and the user's preferences and settings are installed on the computer. (See, e.g., FIG. 7 in *Du*.) The reference has no relevance to operations or tools used by a smart card issuer for personalizing batches of smart cards. The *Du* reference is in the field of personalizing computers. In *Du*, the end-user is queried about the user's PC preferences and settings and those responses are stored on a smart card. The queries and the responses from the user have nothing to do with smart card features as recited in the claims. *Tushie* does not cure this deficiency, namely, that *Du* is about portable or mobile PC settings stored on a smart card and does not address creating batches of smart cards by a card issuer.

C. *Du* Is Not in the Appellant's Field of Endeavor

The Examiner's Answer states that a prior art reference "must either be in the field of appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the appellant was concerned." Appellant stands by its assertion that it would not have been obvious to combine *Du* with *Tushie* because the art in these two references are different. (See Appeal Brief, pages 9-10.) It would not make sense for a person skilled in the field of personalizing batches of smart cards to look to how end-user settings and preferences on a PC can be stored and downloaded from a smart card. It would go against common sense for someone trying to personalize a smart card to be

concerned with how to make it easier to make a computing environment portable. The Technical Field description in the Background section of *Du* states it best:

The invention relates to mobile computing in a computer environment. More particularly, the invention relates to storing, managing, and retrieving a mobile computer user's personal computing environment in a smart card.

This is the only context in which a smart card is discussed in *Du*. The user interface described in *Du* and cited in the Examiner's Answer is for entering personal computing environment settings and is not related to a personalization tool used by a smart card issuer for personalizing a batch of smart cards.

D. The Combination of References Does Not Disclose A Smart Card Issuer's "personalization data file" For Creating a Batch of Smart Cards

The claims recite the term "personalization data file." This file is suitable for personalizing a batch of smart cards issued by a smart card issuer. Quoting from page 4 of Appellant's Appeal Brief: "A personalization data file—generated by asking questions of the card issuer and evaluating the responses—may then be used by the card issuer to personalize the actual smart cards." The personalization data relates to smart card features and output data values, neither of which has to do with personal cardholder data, which is at the center of *Tushie*. The Answer cites portions from *Tushie* that describe a file that contains cardholder data records. The personalization data in this file is used to issue a card for each cardholder. Column 17 of *Tushie* shows two sample cardholder data records. Each one contains an account name, account number, expiration date, date of birth, and medical data. The Examiner's Answer cites these types of data records as disclosing the smart card features data values contained in the claimed "personalization data file" which has no bearing on individual cardholder data. The term "personalization" used in the claims is "personal" with respect to the smart card issuer. It refers to personalizing the smart card issuer's business and risk management decisions and is not related to cardholder data.

IV. CONCLUSION

In view of the foregoing, Appellants respectfully request that the Board reverse the Examiner's rejection under 35 U.S.C. §103 of all pending claims. In addition, Appellants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Respectfully Submitted,

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